



\$1637

Please type a plus sign (+) inside this box →

PTO/SB/21 (08-00)

Approval for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/728,446
	Filing Date	Nov 30, 2000
	First Named Inventor	Friedrich, Glenn
	Group Art Unit	1637
	Examiner Name	J. N. Fredman
Total Number of Pages in This Submission		8
Attorney Docket Number		LEX-0101-USA

RECEIVED
SEP 20 2002
TECH CENTER 1600/290X

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Reply (Restriction)	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): return postcard
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	<div>Remarks</div> <div style="text-align: center;"> 24231 PATENT TRADEMARK OFFICE</div>	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Lance K. Ishimoto Reg. No. 41,866 Lexicon Genetics Incorporated
Signature	
Date	September 16, 2002

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 2327, Arlington, VA 22202 on September 16, 2002 this date:			
Typed or printed name	Nancy Stacey		
Signature		Date	September 16, 2002



#11 / Amendment A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Friedrich *et al.*

Group Art Unit: 1637

Application No.: 09/728,446

Examiner: J. N. Fredman

Filed: 11/30/00

Attorney Docket No.:

Title: Novel Murine Polynucleotide Sequences and Mutant Cells and Mutant Animals Defined Thereby

LEX-0101-USA

TECH CENTER 1600/2900

SEP 20 2002

RECEIVED

AMENDMENT AND RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS

Commissioner for Patents
Washington, D.C. 20231

Sir:

The Examiner is respectfully requested to enter the following amendments. A response to the Restriction and Election Requirement mailed May 14, 2002 ("the Requirement" Paper No. 9) is also included herewith and the Examiner is respectfully requested to consider the remarks therein.

A Petition for an Extension of Time of three months to and including September 14, 2002, which falls on a Saturday, and is therefore extended until September 16, 2002 under 37 C.F.R. § 1.7, and authorization to deduct the fee as required under 37 C.F.R. § 1.17(a)(3) from Applicant's Deposit Account are included. Applicants believe no fee in addition to the fee for the extension of time is due in connection with this response. However, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-0892.

AMENDMENT

In the claims:

Please cancel claims 1-7, entirely without prejudice and without disclaimer, as drawn to non-elected inventions.

Please amend claim 8 so that the text of the amended claim reads as follows:

Claim 8 (amended). An isolated murine embryonic stem cell line comprising an engineered mutation in a gene identifiable as encoding the polynucleotide sequence of SEQ ID NO:819.

A1



Please add new claim 9 as follows:

A2 Claim 9 (new). An embryonic stem cell line according to Claim 8, wherein said engineered mutation is by a retroviral gene trap vector.

RESPONSE

I. Restriction Requirement

The Examiner has determined that the original claims are directed to four separate and distinct inventions under 35 U.S.C. § 121, as follows:

- Group I: Claims 1-2, drawn to polynucleotides, classified in class 536, subclass 23.1;
- Group II: Claims 3-6, drawn to methods of making polynucleotides, classified in class 435, subclass 91.1;
- Group III: Claim 7, drawn to computer based methods for identification, classified in class 702, subclass 19; and
- Group IV: Claim 8, drawn to stem cell line, classified in class 435, subclass 240.2.

II. Response to Restriction Requirement

In response to the Restriction Requirement mailed May 14, 2002 (Paper No. 9), Applicants hereby elect without traverse to prosecute the claim of Group IV (Claim 8), drawn to isolated murine embryonic stem cells, classified in class 435, subclass 240.2. Accordingly, Claims 1-7 are cancelled without disclaimer and without prejudice as drawn to non-elected inventions. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications.

III. Status of the Claims

Claims 1-7, representing the Group I, II, and III inventions, respectively, have been cancelled without prejudice or disclaimer as drawn to non-elected inventions.

No claim within the Group IV invention has been cancelled. In order to better define the invention of the elected Group IV, the claim presently within the Group IV invention has been amended and new Claim 9 has been added. Applicants further elect SEQ ID NO: 819 for sequence searching and examination.

Claims 8 and 9 are thus presently pending in the case. In compliance with 37 C.F.R. § 1.121(c)(1)(ii), a marked up copy of the original claims is attached hereto as Exhibit A. For the convenience of the Examiner, a clean copy of the pending claims is attached hereto as Exhibit B.

IV. Support for the Claims

Support for amended Claim 8 can be found in the specification at, *inter alia*, Sections 5.0 and 5.7.1 (especially the third full paragraph from the end of this section). Support for new Claim 9 can be found in Section 5 and originally filed Claim 8. In view of the clear support for the amended and new claims, the amendments are not deemed to constitute new matter.

V. Conclusion

The present document is a complete response to the Restriction and Species Election Requirement. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should Examiner Fredman have any questions or comments, or believe that certain amendments of the claims might serve to improve their clarity, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,

September 16, 2002

Date



Lance K. Ishimoto

Reg. No. 41,866

LEXICON GENETICS INCORPORATED
(281) 863-3333



24231

PATENT TRADEMARK OFFICE